

Appl. No. 10/789,230
Amdt. Dated July 18, 2005
Reply to Office action of April 18, 2005

REMARKS/ARGUMENTS

Applicant would like to thank the Examiner for the careful consideration given the present application. Reconsideration of the application is respectfully requested in view of the amendments and remarks provided herein.

Applicant acknowledges with appreciation the indicated allowability of claims 8 and 15 if rewritten into independent form. Such claims have been amended to include the limitations of the base claim and any intervening claims. Accordingly, withdrawal of this rejection and allowance of claims 8 and 15 are respectfully requested.

Claims 1, 3-7, 9-11, 13, 14, 16, 17, 19, and 21-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Booker et al. (U.S. Patent No. 5,881,583). Traversal of this rejection is made for at least the following reasons. Booker et al. does not disclose a flange that encircles a majority of a circumference of an outer edge of an annular shaped member. The Examiner concedes that Booker et al. fails to disclose the use of a flange that encircles an outer portion of the device. The Examiner then states that the placement of the flanges in Booker et al. is merely a design choice. However, it is respectfully submitted that one skilled in the art would not have been motivated by Booker et al. to modify the flanges of Booker et al. such that the flanges encircled a majority of a circumference of an outer edge, as required by independent claims 1 and 13 of the present application. Applicant discovered that placement of a flange that encircles a majority of a circumference of an outer edge effectively hides the rim of the basketball hoop from a user's view, thereby aiding in the training of the user. The claimed flange has an entirely different purpose and function from the coupling of Booker. Thus, a modification of Booker to meet the claimed limitations could not be considered a mere design choice.

35 U.S.C. § 103 requires some suggestion or motivation in the prior art to make the new combination. A suggestion or motivation to modify prior art teachings may appear in the content of the public prior art, in the nature of the problem addressed by the invention, or even in the knowledge of one of ordinary skill in the art. As previously stated, the structure expressly set forth in Booker could not logically encircle a majority of the outer edge of the cover member of Booker by mere repositioning. Rather, the coupling of Booker would need to be entirely reconfigured to meet the limitations of the present invention. There is nothing within the teachings of Booker that would teach or suggest such a modification.

Thus, because Booker does not teach or suggest each and every limitation as set forth in independent claims 1 and 13, Booker cannot render such claims obvious.

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Regarding claims 3 and 4, the Examiner relies on aperture 30 as being equivalent to the claimed rod receiving structure; however it is not clear what the Examiner considers as being an equivalent structure to the claimed arm. Assuming that the Examiner considers the coupling members 22 as being equivalent to the claimed arm, it is submitted that the Examiner cannot rely on the coupling members 22 as being equivalent to both the claimed flange and the claimed arm. Clarification of this rejection is requested.

Regarding claim 7, again, it is not clear what structure the Examiner is relying upon as being equivalent to the claimed plurality of protrusions as the Examiner merely cites Fig. 2 without further explanation. For the purposes of this argument, it will be assumed that the Examiner is relying upon the "inner" coupling members 22 as being equivalent to the claimed plurality of protrusions. Assuming this, it is submitted that these two inner coupling members 22 do not create a circular path, as required by claim 9.

Because Booker does not teach or suggest each and every limitation set forth in claims 1, 3-7, 9-11, 13, 14, 16, and 21-22, Booker cannot render obvious such claims. Claims 17 and 19 were cancelled in a previous action. For at least these reasons, withdrawal of this rejection is requested.

Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Booker et al. in view of Official Notice. Traversal of this rejection is made for at least the following reasons. Claims 2 and 12 depend directly or indirectly from claim 1, which is believed to be allowable over Booker et al. for at least the reasons discussed above. The Examiner's statement of Official Notice does not make up for the deficiencies of Booker et al. with respect to claim 1. Accordingly, the combination of Booker et al. and the Examiner's Official Notice does not render obvious claims 2 and 12. Withdrawal of this rejection is respectfully requested.

Claims 1, 3-7, 9-11, 13, 14, 16, 17, 19, and 21-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll (U.S. Patent No. 2,710,189) in view of Gates (U.S. Patent No. 5,207,789). Traversal of this rejection is made for at least the following reasons. As stated above, there must be some teaching or suggestion in the cited references to make the proposed combination. Carroll is directed to a disc-like lid or cover 14 adapted to fill the area between the confines of a basketball rim 10. The lid or cover 14 includes a plurality of clips coupled thereto, which engage the ring to releasably hold the lid or cover 14 in position. Gates is directed to a device attached on top of a basketball rim so as to reduce an inside diameter of the rim. The device includes a downwardly extending inner edge 12 and a

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downwardly extending outer edge 14 all integrally formed so that the device is one piece. In order to removably affix the device to the rim 16, there are provided a plurality of fasteners 22. Each fastener 22 has a threaded male member 24 and a threaded female member 26. The top of each threaded male member 24 is preferably slotted to accommodate a screwdriver, and the top portion 10 of the device is preferably countersunk so that the threaded male members will not extend above the top surface of the top portion 10. Each of the female threaded members 26 has outwardly extending tabs 28 that will engage beneath the rim 16 so that when the fasteners 22 are tightened the rim will be held between the tabs 28 and the bottom surface of top portion 10. Given the simple snap fit connection of Carroll, one skilled in the art would not have been motivated to modify the device of Carroll to the more complicated coupling of Gates. *The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.* *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Examiner suggests that one would have been motivated to make the proposed combination in order to more securely ensure that the device would not come off during use. However, there is no evidence that the Carroll device would have problems coming off the basketball rim during use. Nor does Gates teach or suggest that the disclosed coupling method of Gates is an improvement over a coupling method, such as that disclosed in Carroll.

The device of Gates requires the downwardly extending outer edge 14 to balance the downwardly extending inner edge 12. The device of Carroll does not require and further, would receive no benefit of, a downwardly extending outer edge 14. In fact, such a modification would add increased difficulty to the coupling of the Carroll device to the basketball rim. For at least these reason, the combination of Carroll and Gates does not render claims 1, 3-7, 9-11, 13, 14, 16, and 21-22 obvious. Claims 17 and 19 were cancelled in a previous action. Withdrawal of this rejection is respectfully requested.

Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll in view of Gates and further in view of Official Notice. Traversal of this rejection is made for at least the following reasons. Claims 2 and 12 depend directly or indirectly from claim 1, which is believed to be allowable over the proposed combination of Carroll and Gates for at least the reasons discussed above. The Examiner's statement of Official Notice does not make up for the deficiencies of Carroll and Gates with respect to claim 1. Accordingly, the proposed combination of Carroll, Gates, and the Examiner's Official Notice


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does not render obvious claims 2 and 12. Withdrawal of this rejection is respectfully requested.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 36352US1.

Respectfully submitted,
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